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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/041,714

01/08/2002

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34250-0841

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7590 11/13/2008
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EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

11/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/041,714 | AHLES ET AL. | |
| | Examiner | Art Unit | |
| | OJO O. OYEBISI | 3696 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/29/08, 05/27/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1- 29 and 38 are rejected by the present final Office Action. By the present amendment, independent claims 1, 7, 11, 24, and 38 have been amended to clarify the scope of the claimed invention. Claims 1 - 29 and 38 remain pending in the application

Claim Rejections - 35 USC §101

1. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-29, and 38 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

3. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (*In re Bilski*), §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

4. If neither of these requirements is met by the claim(s), the claimed invention is not a patent eligible process under 35 U.S.C. §101.

5. In this particular case, regarding the first test, in performing the steps of the claimed subject matter in claims 1-6, and 8-29, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter in claims 1-6, and 8-29 may be performed using only human intelligence; the steps do not sufficiently transform the underlying subject matter to be statutory. Thus, to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied and should sufficiently transform the underlying subject matter. Further, the claimed subject matter recited in claims 7 and 38, though system claims, do not sufficiently transform the underlying subject matter to be statutory. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-29, and 38 are rejected under 35 U.S.C. 103(a) as being anticipated by Carney et al (Carney, hereinafter, US PAT: 5,890,141) in view of Chapman (US PAT: 5,432,506).

Re claim 1. Carney discloses a method of receiving a check identifier entered by a user, the method comprising: requesting a user to review an original check identifier in MICR format (see abstract), the original check identifier comprising a plurality of fields separated by separator symbols, the plurality of fields including a routing number field, an account number field and a check number field (see fig.1), thereby obtaining a substitute check identifier with replacement symbols; the substitute check identifier comprising the plurality of numeric fields separated by the replacement symbols; requesting the user to enter the substitute check identifier; and identifying the routing number field, the account number field and the check number field within the entered substitute check identifier (see fig.1 elements 30, 40 and 50, also see fig.4 elements 510, 530, see col.4 lines 32-56). Carney does not explicitly disclose instructing the user to replace the separator symbols of the original check identifier in MICR format with non-numeric replacement symbols. However, Chapman discloses instructing the user to replace the separator symbols of the original check identifier in MICR format with non-numeric replacement symbols (see col.2 lines 4-10). It would have been obvious to combine the teachings of Carney and Chapman to verify the authenticity of the check in order to reduce counterfeiting and forgery.

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Re claim 2. Carney further discloses the method wherein the user uses a computer keyboard to enter the replacement symbols keyboard (Carney discloses inputting MICR data, see fig.4 elements 510 and 530 which is obviously done by the use of a computer keyboard).

Re claim 3. Carney does not explicitly disclose the method wherein the users use a telephone keypad to enter the replacement symbols. However, as per these features, the Examiner asserts that it is well known in the art at the time of the invention for a purchaser or buyer performing a remote purchase to either use a touch tone phone to input their check number or the MICR line. The user may also opted to speak these information to an operator or a voice recognition system. Thus it would have been obvious to one of ordinary skill in the art to incorporate such a feature in the system of Carney in order to allow or facilitate remote purchasing by a customer or user from a remote merchant.

Re claim 4. Claim 4 recites similar limitations to claim 1 and thus rejected using the same art and rationale as in claim 1 supra.

Re claim 5. Carney further discloses the method further comprising instructing the user to enter the substitute check identifier with a computer keyboard (Carney discloses inputting MICR data, see fig.4 elements 510 and 530 which is obviously done by the use of a computer keyboard).

Re claim 6. Claim 6 recites similar limitations to claim 3 and thus rejected using the same art and rationale as in claim 3 supra

Re claim 7. Carney further discloses a computer program for check entry comprising:, obtaining a substitute check identifier, the original MICR format check identifier comprising numeric fields separated by the separator symbols, and the substitute check identifier comprising the numeric fields separated by the non-numeric replacement symbols; and computer code stored on a computer-readable medium configured to instruct the user to enter the substitute check identifier into at least one of a computer system or a telephone system (i.e., input check (j), input MICR(J), see fig.4 elements 510 and 530, also fig.7 lines 18-25) or a telephone system. Carney does not explicitly disclose a module computer code stored on a computer-readable medium configured to instruct a user to replace the separator symbols within an original MICR format check identifier with replacement symbols. However, Chapman explicitly discloses a module computer code stored on a computer-readable medium configured to instruct a user to replace the separator symbols within an original MICR format check identifier with replacement symbols (see col.2 lines 4-10). It would have been obvious to combine the teachings of Carney and Chapman to verify the authenticity of the check in order to reduce counterfeiting and forgery.

Re claim 8. Claim 8 recites similar limitations to claim 7 and thus rejected using the same art and rationale as in claim 7 supra.

Re claim 9. Claim 9 recites similar limitations to claim 5 and thus rejected using the same art and rationale as in claim 5 supra.

Re claim 10. Claim 10 recites similar limitations to claim 3 and thus rejected using the same art and rationale as in claim 3 supra.

Re claim 11. Claim 11 recites similar limitations to claim 7 and thus rejected using the same art and rationale as in claim 7 supra.

Re claim 12. Claim 12 recites similar limitations to claim 5 and thus rejected using the same art and rationale as in claim 5 supra.

Re claim 13. Claim 13 recites similar limitations to claim 3 and thus rejected using the same art and rationale as in claim 3 supra.

Re claim 14. Carney further discloses the method of Claim 11 wherein the replacement symbol is an asterisk (Carney discloses inputting MICR data, see fig.4 elements 510 and 530 which is obviously done by the use of a computer keyboard. The examiner further asserts that an asterisk symbol can be found on the computer keyboard).

Re claim 15. Carney further discloses the method of Claim 11 wherein the replacement symbol is a "#" symbol (Carney discloses inputting MICR data, see fig.4 elements 510 and 530 which is obviously done by the use of a computer keyboard. The examiner further asserts that "#" symbol can be found on the computer keyboard).

Re claims 16, 17-18. Carney further discloses the method wherein the act of processing the substitute check identifier identifies the routing number by searching for a field comprising at least nine digits (i.e., At block 520 and 530, the MICR data is inputted and stored at (J) index value location in the system. The system at; block 540 interprets the payee name and other appropriate check data, including the algorithm number and check digit if printed on the face or MICR line of the check, then applies the appropriate algorithm to the captured MICR line and image to generate a check digit value CD (J). At test 550, if the algorithm number and/or check digit are not found

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on the check, the system queries as to the existence of a paid issuance file, previously transferred from the drawee bank, see col.7 lines 18-40).

Re claim 19. Carney further discloses the method wherein the act of processing the substitute check identifier identifies the account number by first identifying the routing Field (see fig.1 element 30).

Re claim 20. Carney further discloses the method wherein the act of processing the substitute check identifier identifies the check number by comparing the fields in the substitute check identifier to a separately entered check number (see col.4 lines 25-31).

Re claim 21. Carney further discloses the method wherein the replacement symbol exists between the account number and the routing number (see fig.1 element 30, 40, and 50).

Re claim 22. Carney further discloses the method wherein the replacement symbol exists between the account number and the check number (see fig.1 element 30, 40, and 50).

Re claim 23. Carney further discloses the method wherein the replacement symbol exists at the beginning of the check identifier (see fig.1 element 30, 40, and 50).

Re claim 24. Claim 24 recites similar limitations to claim 7 and thus rejected using the same art and rationale as in claim 7 supra.

Re claim 25. Carney further discloses the method, wherein the user is a customer (see the abstract)

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Re claim 26. Carney further discloses the method, wherein the user is a merchant operator (see the abstract).

Re claim 27. Carney further discloses the method, further comprising: verifying that the entered substitute check identifier includes at least one replacement symbol, and if the substitute check identifier does not include at least one replacement symbol, instructing the user to enter a substitute check identifier with at least one replacement symbol (i.e., At block 520 and 530, the MICR data is inputted and stored at (J) index value location in the system. The system at; block 540 interprets the payee name and other appropriate check data, including the algorithm number and check digit if printed on the face or MICR line of the check, then applies the appropriate algorithm to the captured MICR line and image to generate a check digit value CD (J). At test 550, if the algorithm number and/or check digit are not found on the check, the system queries as to the existence of a paid issuance file, previously transferred from the drawee bank, see col.7 lines 18-40)

Re claim 28. Carney further discloses the method, wherein the act of parsing comprises identifying a first nine-digit distinguished field within the substitute check identifier as the routing number (see fig.1 elements 30, 40, and 50).

Re claim 29. Carney further discloses the method, wherein the act of parsing comprises identifying a distinguished field that matches the user-entered check number as the check number field, and identifying the routing number field (i.e., At block 520 and 530, the MICR data is inputted and stored at (J) index value location in the system. The system at; block 540 interprets the payee name and other appropriate check data,

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including the algorithm number and check digit if printed on the face or MICR line of the check, then applies the appropriate algorithm to the captured MICR line and image to generate a check digit value CD (J). At test 550, if the algorithm number and/or check digit are not found on the check, the system queries as to the existence of a paid issuance file, previously transferred from the drawee bank, see col.7 lines 18-40).

Re claim 38. Claim 38 recites similar limitations to claim 7 and thus rejected using the same art and rationale as in claim 7 supra.

Response to Arguments

Applicant's arguments with respect to claims 1-29, and 38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

/O. O. O./
Examiner, Art Unit 3696